

U.S. Patent Application No. 10/723,208
Amendment dated January 4, 2005
Reply to Office Action of October 4, 2004

REMARKS/ARGUMENTS

Reconsideration and continued examination of the above-identified application are respectfully requested.

The amendment to the claims further defines what the applicants regard as their invention. In particular, typographical and/or editorial errors were corrected in claims 1, 2, 4, and 6. The scope of these claims remains unchanged, except that claim 1 is further amended to revise the proviso in the last two lines to provide that when R^1 , R^2 , and R^4 each are hydrogen, R^5 and R^6 do not represent OR⁷ at the same time. New claim 9 is added as an independent claim directed to a composition comprising a compound of Formula I wherein the substituents are defined as they were in claim 1 before the Preliminary Amendment of November 26, 2003 and an ophthalmologically acceptable carrier. New dependent claim 10 further defines the composition of claim 9 by adding the same limitations to the compound of Formula I that are recited in claim 2. New dependent claims 11 - 14 are similar to original claims 3 - 6, except depending from claim 9 or claim 10 instead of from claim 1. Full support for these amendments can be found throughout the present application including the claims as originally filed. For example, the specification on pages 7 - 8 provides support for a composition comprising an ophthalmologically acceptable carrier. The amended proviso in claim 1 is a subgenus of the original claim that is supported by the original genus and by the Examples 2 - 12, all of which fall within the subgenus defined by the proviso. Accordingly, no questions of new matter should arise and entry of this amendment is respectfully requested.

Request for Confirmation of Non-Finality of Office Action

The Office Action dated October 4, 2004 is the first Office Action on the merits in the

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above-identified application. However, in the Status section of the Office Action Summary, both Box 2a indicating that an action is final and Box 2b indicating that an action is non-final were checked. Since none of the conditions set forth in MPEP 706.07(b), relating to first action final rejections of continuing applications, apply to the present application, it is not proper for the present Office Action to be a final action. Accordingly, Applicants request written confirmation as soon as possible that the Office Action of October 4, 2004 is not a final action.

Restriction and Election

The Examiner formally set forth the restriction requirement that was made by telephone on September 2, 2004. In particular, the restriction was drawn between Group I (claims 1, 2, and 7, drawn to compounds of Formula I and compositions thereof) and Group II (drawn to methods of using the compounds of Formula I). The reference on page 2 of the Office Action to claims 10 - 12 appears to be an error, since claims designated as 10 - 12 had never existed in the application at the time of the Office Action. Until the present amendments, the highest claim number ever presented in the application was claim 8.

In response to the restriction requirement, Applicants affirm the election of the compound and composition claims, Group I, with traverse. Applicants note that new claims 9 and 10 are composition claims that should be included in Group I and that new claims 11 - 14 are method claims that should be included in Group II. The restriction is traversed on the grounds that examination of both the compound claims and the method claims would not impose a serious burden on the Examiner, particularly since both groups of claims have already been searched in the corresponding International Application, PCT/US02/16842. Moreover, Applicants specifically request that upon allowance of the compound claims, the Examiner rejoin and allow

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all of the method claims, including claims 3 - 6, and 8 and new claims 11 - 14 added herein. The method claims 3 - 6, 8, and 11 - 14 are commensurate in scope with the either the compound claims or the composition claims.

Regarding the election of species, the Examiner states that in response to the telephone restriction, the compound of Formula I was elected wherein the aryl ring is a benzene ring; A = H; R¹, R², and R³ = H and R⁴ and R⁶ = OR⁷, wherein R⁷ is a methyl group. This characterization of the election of species seems to be incomplete, since no selection is given for R⁵; also, the characterization is inaccurate, since, in Formula I, the definition of R⁴ does not include OR⁷ as a possible selection. The contemporaneous notes made by the undersigned regarding the telephone conversation with the Examiner on September 2, 2004 show that the elected species was the compound of Formula I wherein the aryl ring is a benzene ring; A = H, R¹, R², R³, and R⁴ = H and R⁵ and R⁶ = OR⁷, wherein R⁷ is a methyl group. However, this election also appears to have been an error, since it does not fall within the scope of independent claim 1 as amended in the Preliminary Amendment filed on November 26, 2003. In particular, amended claim 1 (before the present amendments) specifically required that when R¹, R², R³, and R⁴ each are hydrogen, R⁵ and R⁶ cannot both be OR⁷. Accordingly, if the Examiner continues to require an election of species, then the Examiner is requested to consider the elected species to be the closest compound to the originally elected species falling within the scope of claim 1, which would be the compound of Formula I wherein the aryl ring is a benzene ring; A = H, R¹, R², R³, R⁴, and R⁶ = H and R⁵ = OR⁷, wherein R⁷ is a methyl group.

Rejection of Claims 1, 2, and 7 under 35 U.S.C. §102(a) over Clare

Claims 1, 2, and 7 were rejected under 35 U.S.C. §102(a) as being anticipated by Clare.

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"The Frontier Orbital Phase Angles: Novel QSAR Descriptors for Benzene Derivatives, Applied to Phenylalkylamine Hallucinogens," J. Med. Chem. Vol. 41, pp. 3845-3856 (1998). The Examiner alleges that Clare relates to naphthalene derivatives that read on the claims wherein R¹ - R⁴ represent [omitted in the Office Action, assumed to be H], R⁵ and R⁶ represent OMe, A is H and the aryl ring is a benzene ring. These selections appear to correspond to compound 46 of Clare. For the following reasons, this rejection is respectfully traversed.

Since claim 1, as amended in the preliminary amendment filed on November 26, 2003, contains the proviso that if R¹ - R⁴ are hydrogen, then R⁵ and R⁶ cannot both be OR⁷ (for example, they cannot both be methoxy groups) (and as further amended herein to provide that if R¹, R² and R⁴ are hydrogen, then R⁵ and R⁶ cannot both be OR⁷), Clare does not teach the claimed invention. Accordingly, claims 1, 2, and 7 are clearly not anticipated by the compound set forth in Clare since in the compound of Clare, R¹ - R⁴ are all hydrogen and R⁵ and R⁶ are both OMe, which represents a selection specifically excluded in the amended claim 1. Moreover, because the Examiner has not presented any reason why a person skilled in the art would modify the compound of Clare to obtain a compound wherein when R¹ - R⁴ are H, then R⁵ and R⁶ cannot both be OR⁷, it is respectfully submitted that claims 1, 2, and 7 would not have been obvious over Clare.

Regarding claims 9 and 10, these claims are directed to a composition comprising a compound of Formula I wherein the substituents are defined as they were in the original claim 1 (that is, without a proviso described above limiting R⁵ and R⁶) and an ophthalmologically acceptable carrier. Because Clare does not teach or suggest an ophthalmic composition for its compound, claims 9 and 10 are clearly allowable.

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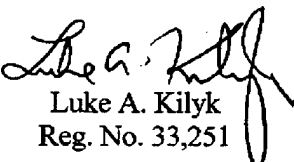
Since the compound and composition claims are clearly allowable, it is respectfully submitted that the method of use claims 3 - 6, 8 should be rejoined and are also allowable, along with new method of use claims 11 - 14.

CONCLUSION

In view of the foregoing remarks, the applicant respectfully requests the reconsideration of this application and the timely allowance of the pending claims.

If there are any other fees due in connection with the filing of this response, please charge the fees to Deposit Account No. 50-0925. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and should also be charged to said Deposit Account.

Respectfully submitted,


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